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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FLORIAN U. BOMERS

Appeal 2009-014994
Application 10/699,968
Technology Center 2100

Before GREGORY J. GONSALVES, KALYAN K. DESHPANDE, and MICHAEL R. ZECHER, *Administrative Patent Judges*.

GONSALVES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the rejection of claims 1-4 and 6-24. (App. Br. 1.) Claim 5 was cancelled. (*Id.*) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

The Disclosed Invention

Exemplary independent claim 1 follows:

1. A computer readable medium storing a computer program configured for execution by a personal computer (PC) and comprising:

program instructions to create event translators that translate incoming input events to said PC into translated input events according to user-defined translation behaviors;

program instructions to associate each event translator with a type of incoming input event responsive to user input; and

program instructions to configure a translation behavior for each event translator responsive to user input, such that during execution of the computer program by the PC the event translator generates a desired translated input event responsive to receiving an incoming input event to said PC of the type of incoming input event associated with the event translator, including program instructions to define a translation function that modifies incoming input events to said PC according to one or more user-configured functions.

The Examiner rejected claim 23 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. (Ans. 4.)

The Examiner rejected claim 23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Ans. 5.)

The Examiner rejected claims 1-4, 6-8, and 11-24 under 35 U.S.C. § 103(a) as being unpatentable based on Davenport (U.S. 2004/0263477 A1) and Bear (U.S. 2004/0257341 A1). (Ans. 5-17.)

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable based on Davenport, Bear, and King (U.S. 2003/0071842 A1). (Ans. 17-18.)

ISSUES

Appellant's responses to the Examiner's positions present the following issues:

1. Did the Examiner err in finding that one of ordinary skill in the art, in light of the teachings of Bear, would have implemented Davenport's method on a personal computer, as required by each of independent claims 1, 11, 12, and 14?

2. Did the Examiner err in finding that Davenport teaches or suggests "program instructions to determine whether the incoming input event is swallowed or passed-through," as recited in claim 6?

3. Did the Examiner err in finding that Davenport teaches or suggests "a swallowing of the given input event to hide it from one or more other computer processes," as recited in claim 17, and as similarly recited in claim 24?

4. Did the Examiner err in finding that Davenport teaches or suggests "program instructions to time-delay input events of the selected type according to a desired time-delay value," as recited in claim 20?

5. Did the Examiner err in finding that claim 23 is invalid under either the first or second paragraphs of § 112 for failing to satisfy the enablement requirement or for failing to particularly point out the invention, respectively?

ANALYSIS

Issue 1 – Obviousness Rejections of Claims 1-4, 6-16, 18, 19, and 21-23

We have reviewed the Examiner's rejections in light of Appellant's arguments (Appeal Brief) that the Examiner has erred. We disagree with Appellant's conclusion regarding the obviousness of claims 1-4, 6-16, 18, 19, and 21-23. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer (Ans. 3-11) in response to the Appellant's Appeal Brief. We concur with the conclusion reached by the Examiner. But we highlight and address specific findings and arguments regarding certain claimed limitations such as the determination of "whether the incoming input event is swallowed or passed-through," the delay of "input events of the selected type according to a time-delay value," and a "mathematical function."

Appellant contends that one of ordinary skill in the art would not have implemented the method taught by Davenport on a personal computer because "Davenport explicitly specifies implementation outside of and independent from a PC or other computer." (App. Br. 10.) As explained by

the Examiner, however, when Davenport's external device is connected to a personal computer they operate "as a complete system." (Ans. 19.) And it would have been obvious to move the functionality relating to event processing from the external device to the personal computer with predictable results. (*See e.g.*, Ans. 19.) In other words, "the functionality of appellant's invention being incorporated within the pc does not make the invention novel." (Ans. 19.) For these reasons and the reasons expressed in the Examiner's Answer, we sustain the Examiner's obviousness rejections of independent claims 1, 11, 12, and 14. We also sustain the Examiner's obviousness rejections of certain claims that depend from the independent claims (*i.e.*, claims 2-4, 7-10, 13, 15, 16, 18, 19 and 21-23) because Appellant either did not set forth any separate patentability arguments for those claims or set forth arguments that are similar to those expressed for independent claims 1, 11, 12, and 14. (*See* App. Br. 7-19.)

Appellant also contends that claim 6 is not obvious because contrary to the Examiner's reasoning, Davenport's event linking does not qualify as "the claimed swallowing." (App. Br. 13.) As explained by the Examiner, however, the lack of any explicit definition for the claim term "swallowing" indicates that the term "can take on many forms, for example making one event appear as another...." (Ans. 20.) Accordingly, we find that the Examiner, "giving the claim its broadest reasonable meaning consistent with the Specification," *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), properly relies on the event linking as taught by Davenport to encompass the claimed "swallowing." For these reasons and the reasons expressed in the Examiner's Answer, we sustain the Examiner's rejection of claim 6.

Issue 2 – Obviousness Rejections of Claims 17, 20 and 24

Appellant asserts, like he did for claim 6, that claims 17 and 24 are not obvious because Davenport's event linking does not qualify as "the claimed swallowing." (App. Br. 13.) In response, the Examiner again reasons that a broad construction of the term "swallowing" encompasses Davenport's event linking. (Ans. 20.) But unlike claim 6, each of claims 17 and 24 explicitly require a particular type of swallowing: the swallowing of an input event to hide it from other computer processes. And the Examiner fails to provide any meaningful explanation as to how the Davenport's event linking hides an event from other computer processes. (*See* Ans. 20.) For these reasons and the reasons expressed in Appellant's Brief, we reverse the Examiner's obviousness rejections of claims 17 and 24.

Appellant also asserts that claim 20 is not obvious because Davenport does not teach or suggest "program instructions to time-delay input events of the selected type according to a desired time delay value." (App. Br. 18 (emphasis omitted).) Appellant argues that, contrary to the Examiner's reasoning, controlling a time delay between pressing and releasing a button on a mouse does not meet this claim limitation because that delay is controlled by the user and the claim requires program instructions to create a time delay. (App. Br. 18-19.) We agree. For this reason, we do not sustain the Examiner's obviousness rejection of claim 20.

Issue 3 – Section 112 Rejections of Claim 23

The Examiner rejected claim 23 under both the first and second paragraphs of Section 112 for failing to comply with the enablement requirement and for failing to particularly point out the invention,

respectively. (Ans. 4-5.) The Examiner reasons that Appellant has "disclosed a mathematical function but do not disclose if mathematical scaling is configured within this function." (Ans. 4.) But Appellant reasons that "the application of a mathematical scaling to one or more event parameters of an incoming event is supported in the filed application at least at paragraphs [0010], [0017], and [0020] (attenuating)." (App. Br. 8.) And Appellant also reasons that "mathematical scaling is well understood by those skilled in the art, and the filed specification underscores that meaning by highlighting attenuation (which is understood to be a type of fractional scaling) as an example." (App. Br. 9.) We agree with Appellant's reasoning. Accordingly, we do not sustain the Examiner's Section 112 rejections of claim 23.

DECISION

We affirm the Examiner's decision rejecting claims 1-4, 6-16, 18, 19, and 21-23 as obvious. But we reverse the Examiner's decision rejecting claims 17, 20, and 24 as obvious, and claim 23 as indefinite and not enabled.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

ELD